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| 10/005,428 | 12/03/2001 | Stephen M. Key | PA2321 | 1741 |
| 22830 | 7590 | 10/21/2003 | | |
| CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303 | | | EXAMINER ZIRKER, DANIEL R | |
| | | | ART UNIT | PAPER NUMBER |

1771

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/16/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 24-35, 39-48 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 24-26, 32-35, 39-48 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 0106
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-848
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24, 32, 35, 39-41, 43 and 46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claims 32 and 46 as they now read are de facto duplicate claims, despite the differences in the preamble; it further appears that claims 32 and 35 are as well. Claims 39-41 and 43 define various "species" of adhesive in terms of elements (e.g. electrocharge, wetting agent, pressure) which greatly misuse the term as it is known in the chemical literature.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, applicant uses the terms "temporary adhesive" and "permanent adhesive" which, although known in the art, are not defined in applicant's specification in any meaningful manner so as to define the boundaries of each of the two. This is particularly important, in the Examiner's opinion, since the

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relied upon prior art appears to disclose adhesives that can be both "temporary" and "permanent" depending upon the particular range of proportions of ingredients that are utilized. Additionally, the disclosure involving just how a "temporary adhesive" can be an "electrocharge", "wetting agent", or "pressure" is nowhere discussed except to briefly mention each of these elements. In summary, applicant's specification with respect to its disclosure relating to suitable adhesives appears nothing more than to be an invitation to experiment.

4. Claims 24-26, 32-35 and 39-48 are rejected under 35 U.S.C. § 112 first paragraph as being based upon a non-enabling specification for the reasons set forth above.

5. Claims 24-26, 32-35 and 39-48 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, applicant's claims as they now read require only any suitable label backing coated with either one or both types of adhesives ("temporary" or "permanent") taught in its specification, and it would appear that the presence of an additional label substrate or container is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 24-26, 32-35 and 39-48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Ingle, Fumei or Haines, each taken individually or in view of applicant's admissions in the specification at page 1 line 19 - page 2 line 3. Each of the references discloses (note particularly Ingle, the Abstract, Figures 1 and 4, column 1 lines 5-14, column 2 lines 11-47, column 3 lines 13-40, column 4 lines 8-16; Fumei, the Abstract, Figures 3, 5 and 6, column 1 lines 4-6, column 2 lines 22-51, column 3 lines 17-43, column 4 lines 1-33, column 5 lines 17-23) labels which meet applicant's claim language in certain embodiments, as well as also disclosing in certain embodiments multilayer labels suitable for use as rotatable labels. Additionally, each of the references discloses coating the label with different adhesive strengths in various sections which is believed to be, if not inherently reading upon applicant's claimed "temporary adhesive" and "permanent adhesive"

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language, putting the concept within the state of the art. For example, note Ingle, particularly Figure 4 and column 2 lines 24-40; Haines in Figures 3 and 5 having adhesive present at the end of each label strip which may be modified to produce a desired adhesive strength from a variety of well known adhesives (e.g. column 3 lines 43-45; or Fumei, the Abstract, column 3 lines 29-38, column 4 lines 26-27). With respect to the requirement for a "transparent region", note the admission in the specification at page 1 line 21 and also, e.g. Barnum, Jr. U.S. 2,860,431 at column 3 lines 4-6 as evidence that transparent labels are well known in the art. With respect to the dependent claims, the presence of slip agents (claim 25), the commercially known adhesives set forth in claim 26, ^{and} the presence of heat activated adhesives in claims 42, 44, 45 and 48 are each believed to be well known adhesive compositions in the art, and are clearly inherent in at least some of the relied upon prior art references. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Amberg and U.S. Patent Application Publication to the inventor P2001/0025442A1.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 10, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zirker